



Atty. Dkt. No 017283-0123

DAC

#20

\$

Applicants: Patrick BENOIT ET AL.

Title: AN ISOLATED PEPTIDE OR
POLYPEPTIDE OF THE
EXTRACELLULAR PORTION OF
THE HUMAN INTERFERON
RECEPTOR (IFN-R)

Appl. No.: 09/240,675

Filing Date: 02/02/1999

Examiner: S. Devi

Art Unit: 1645

CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date below. _____ (Printed Name) _____ (Signature) _____ (Date of Deposit)
--

PETITION FOR WAIVER OR SUSPENSION OF RULES UNDER 37 C.F.R. § 1.183

Box DAC
Commissioner for Patents
Washington, D.C. 20231

Sir:

(1) Petition Under 37 C.F.R. § 1.183

Concurrent with this submission, Applicants are filing a response with the ex parte Examiner, Ms. Devi. In that response, Applicants point out why no petition is required, in view of the facts detailed below. If the office takes a different position, however, Applicants have submitted this petition in the alternative.

Applicant hereby petitions that the Office for waive or suspend rules 37 C.F.R. § 1.52 and 37 C.F.R. § 1.67, and to accept inventor declarations as originally filed for the present application. Applicants believe the rules do not adequately govern the extraordinary facts of this case and further request that the office suspend or waive any other applicable rules as justice requires.

(2) Pertinent Facts

All named inventors of the present application executed a declaration which as filed with the Office concurrently with the patent application on February 2, 1999. The declarations were accepted at that time and the Office granted the patent application a filing date of February 2, 1999. Well into prosecution of the present case,

RECEIVED
AUG 05 2002
OFFICE OF PETITIONS

the examiner objected to the original declarations under 37 C.F.R. § 1.52 because at least some of the inventors altered their country of citizenship without initialing the changes, despite signing the declaration thereunder. The examiner requested that Applicants file supplemental declarations under 37 C.F.R. § 1.67. Applicants note that 37 C.F.R. § 1.67 is discretionary and the "Office may require" that the applicants submit a supplemental declaration.

In accordance with MPEP § 409.03(d), Julia Andral-Ziurys, Applicants' patent counsel, made a diligent effort to contact all of the inventors. Supplemental declarations were forwarded, up to three times over five months, to the last known address of each named inventor. To date, Applicants have not received signed supplemental declarations from two of the inventors, Patrick Benoit and Deborah Maquire. Applicants filed the Declaration of Ms. Andral-Ziurys with an office action response dated December 7, 2001. The Andral-Ziurys' declaration provides a statement of facts describing her efforts to contact the absent inventors and includes documents supporting her efforts as Annexes 1-21.

The examiner did not consider Andral-Ziurys' declaration because it was not in a separate paper directed to the Office of Petitions. In an office action dated February 1, 2002, the examiner requested Applicants to file a petition under 37 C.F.R. § 1.47 as some of the inventors were unavailable to file a supplemental declaration.

Applicants believe the rules do not adequately control the facts of this case. First, Applicants believe that 37 C.F.R. § 1.52 is inapplicable to the present case. Applicants contend that 37 C.F.R. § 1.52 is directed to application papers other than the oath or declaration. The language of the rule specifically is directed to application papers altered after the signing of the oath or declaration. Thus, 37 C.F.R. § 1.52 appears improper. Should the Office consider 37 C.F.R. § 1.52 to be applicable to the present case, Applicants request that the Office waive or suspend this rule as justice requires.

Second, Applicants believe that 37 C.F.R. § 1.47 does not adequately control this case. Although Applicants were not able to obtain the supplemental declarations from all inventors, Applicants filed original declarations from all inventors which were accepted by the Office. As a result, the Office granted the application a filing date of February 2, 1999. Thus, 37 C.F.R. § 1.47 does not apply because all

inventors did sign a declaration and the Office granted the application a filing date. Should the Office consider 37 C.F.R. § 1.47 to be applicable to the present case, Applicants request that the Office waive or suspend this rule as justice requires.

Third, Applicants believe that 37 C.F.R. § 1.67 is a discretionary rule that may be waived by the Office. The language of 37 C.F.R. § 1.67 includes the discretionary word "may" and does not include the mandatory language of "shall" or "will." As a result, Applicants request the Office waive or suspend 37 C.F.R. § 1.67 as justice requires.

Lastly, Applicants request the Office to waive or suspend any other applicable rules to permit the original declarations executed by all inventors to be entered in this case.

(3) Petition fee under 37 C.F.R. § 1.17(h)

A check in the amount of \$130.00 is enclosed for the amount stated in 37 C.F.R. § 1.17(h) to cover the fee for this petition.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this petition, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 1 August 2002

By S. A. Bent

FOLEY & LARDNER
Customer Number: 22428

Stephen A. Bent
Attorney for Applicants
Registration No. 29,768



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5404
Facsimile: (202) 672-5399